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Filed : September 12, 2003

REMARKS

Applicants thank the Examiner for the indication of allowable subject matter. Claims 1 and 2 have been amended to exclude disclosed compounds in known prior art references. The structures of claimed compounds have been inserted in Claims 7, 9-10, 12, 14, and 16. Applicants have also corrected a typographical error in Claim 45. In Claim 6, commas have been inserted between each substituents and an "and" has been added between the last two substituents. Claims 39-46 have been amended to add "or salt thereof." The amendments do not constitute addition of new matter. Claims 1-4 and 6-49 are now pending, of which Claims 18-48 are withdrawn.

Rejections Under 35 U.S.C. §112

The Examiner rejected Claims 7, 9-10, 12, 14, and 16 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. Applicants have amended these claims to insert the structures of each claimed compounds as defined in the specification. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of Claims 7, 9-10, 12, 14, and 16.

Rejections Under 35 U.S.C. §102(b)

The Examiner rejected Claims 1-4, 7 and 17 under 35 U.S.C. §102(b) as being anticipated by Farina et al. (IL Farmaco, 2001, Vol. 56, pp. 113-116). According to the Examiner, Farina et al. disclosed the instant claimed compound on page 115, Table 6, compound 6b.

Applicants respectfully assert that the disclosed compound 6b in Farina et al. is outside of the scope of Claims 1 and 17. Both Claims 1 and 17 require that an NHCOR_2 group be attached to the single phenyl ring; however, the claimed compound 6b in Farina et al. only has a CONHR and a hydroxyl substituent on the single phenyl ring. In addition, Claims 1 and 17 include a limitation that "one of Q, T, X and Z is N" and a limitation that "one of T and X is N," respectively. On the other hand, the compound 6b contains no pyridine ring in its structure. As a result, compound 6b does not anticipate Supragenus A in Claim 1 or the genus in Claim 17.

The Examiner also rejected Claims 1-4, 7 and 17 under 35 U.S.C. §102(b) as being anticipated by Viscardi et al. (Journal of Heterocyclic Chemistry, 1990, Vol. 27, pp. 1825-9).

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Applicants have amended Claims 1 and 2 such that the definition of M does not encompass hydroxyl. As a result, the amended Claims 1 and 2 do not recite any of the cited compounds and are not anticipated by Viscardi et al.

Applicants respectfully assert that Claim 17 does not recite any of the cited compounds in Viscardi et al. Claim 17 only has a NHCOR_2 group on the single phenyl ring, while all the cited compounds have a hydroxyl substituent on the single phenyl ring in addition to an NHCOR group. As a result Claim 17 is not anticipated by Viscardi et al. Accordingly, Applicants respectively request that the Examiner withdraw the objections under 35 U.S.C. § 102(b).

Rejections Under 35 U.S.C. §102(e)

The Examiner rejected Claims 1-4, 6-7 and 17 under 35 U.S.C. §102(e) as being anticipated by Rubin et al. (US 2005/0085519). Applicants have amended Claims 1 and 2 such that the definition of M does not encompass halogen. As a result, the amended Claims 1 and 2 do not recite any of the cited compounds and are not anticipated by Rubin et al.

Again, Claim 17 does not recite any of the cited compounds in Rubin et al. Claim 17 only has a NHCOR_2 group on the single phenyl ring, while all the cited compounds have a chlorine substituent on the single phenyl ring in addition to an NHCOR group. As a result, Claim 17 is not anticipated by Rubin et al. Applicants respectively request that the Examiner withdraw the objections under 35 U.S.C. § 102(e).

Rejoinder

In the Amendment filed on October 10, 2006, an election was made without traverse to prosecute the invention of Group I, Claims 1-17. Accordingly, Groups II-IV, including Claims 1-17, which are directed to a compound or salt thereof of Supragenera A-D, wherein two, three or four of the Q, T, X and Z are N, Groups V-VIII, including Claims 18-38, which are directed to a method for treating or preventing allergic reaction and/or inhibiting cytokines or leukocytes in a mammal comprising administration of a compound of Supragenera A-D, Group IX-VII, including Claims 39-46, which are directed to a method for preparing a compound or salt thereof of Supragenera A-D, were withdrawn from consideration. In addition, Claims 47-48 that are directed to a pharmaceutical composition comprising any one or more of the compounds or salts

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thereof in Claim 1 and were added in the Amendment filed on October 10, 2006 have also been withdrawn.

According to M.P.E.P. 821.04, where product and process claims drawn to independent and distinct inventions are presented in the same application, Applicant may be called upon under 35 U.S.C. § 121 to elect claims to either the product or process. The claims to the non-elected invention will be withdrawn from further consideration under 37 C.F.R. § 1.142. However, if Applicant elects claims directed to the product and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined.

All of Claims 18-48 now depend from Claim 1 and recite all of the limitations of the allowed product claims. The Applicants respectfully request rejoinder of Claims 18-48, in accordance with M.P.E.P. 821.04.

CONCLUSIONS

In view of the remarks set forth above, Applicants respectfully submit that Claims 1-4 and 6-17 in the present application is fully in condition for allowance. Should there be any questions concerning the application, the Examiner is respectfully invited to contact the undersigned at telephone number appearing below. Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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